

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of Itamer WILLNER

Application No.: 09/899,936

Filed: November 19, 2001

Conf. No. 4415

Art Unit: 1641

Examiner: NC Yang

Washington, D.C.

For: DETECTION OF SMALL MOLECULES BY USE OF A PIEZOELECTRIC SENSOR

Atty.'s Docket: WILLNER5

Date: September 24, 2004

THE COMMISSIONER OF PATENTS
2011 South Clark Place, Mail Stop
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

Sir:

Transmitted herewith is a ☐ Amendment ☒ Reply to Restriction Requirement
in the above-identified application.

☐ Small Entity Status: Applicant(s) claim small entity status. See 37 C.F.R. §1.27.

☒ No additional fee is required.

☐ The fee has been calculated as shown below:

	(Col. 1)		(Col. 2)	(Col. 3)
	CLAIMS REMAINING AFTER AMENDMENT		HIGHEST NO. PREVIOUSLY PAID FOR	PRESENT EXTRA EQUALS
TOTAL	*	MINUS	**	0
INDEP.	*	MINUS	***	0
FIRST PRESENTATION OF MULTIPLE DEP. CLAIM				

SMALL ENTITY	
RATE	ADDITIONAL FEE
x 9	\$
x 43	\$
+ 145	\$
ADDITIONAL FEE TOTAL	
\$	

OTHER THAN SMALL ENTITY	
RATE	ADDITIONAL FEE
x 18	\$
x 86	\$
+ 290	\$
TOTAL	
\$	

- * If the entry in Col. 1 is less than the entry in Col. 2, write "0" in Col. 3.
** If the "Highest Number Previously Paid for" IN THIS SPACE is less than 20, write "20" in this space.
*** If the "Highest Number Previously Paid for" IN THIS SPACE is less than 3, write "3" in this space.

The "Highest Number Previously Paid For" (total or independent) is the highest number found from the equivalent box in Col. 1 of a prior amendment of the number of claims originally filed.

☒ Conditional Petition for Extension of Time

If any extension of time for a response is required, applicant requests that this be considered a petition therefor.

☐ It is hereby petitioned for an extension of time in accordance with 37 CFR 1.136(a). The appropriate fee required by 37 CFR 1.17 is calculated as shown below:

Small Entity

Response Filed Within

- ☐ First - \$ 55.00
☐ Second - \$ 210.00
☐ Third - \$ 475.00
☐ Fourth - \$ 740.00

Month After Time Period Set

Other Than Small Entity

Response Filed Within

- ☐ First - \$ 110.00
☐ Second - \$ 420.00
☐ Third - \$ 950.00
☐ Fourth - \$ 1480.00

Month After Time Period Set

☐ Less fees (\$) already paid for month(s) extension of time on .

☐ Please charge my Deposit Account No. 02-4035 in the amount of \$.

☐ Credit Card Payment Form, PTO-2038, is attached, authorizing payment in the amount of \$.

☐ A check in the amount of \$ is attached (check no.).

☒ The Commissioner is hereby authorized and requested to charge any additional fees which may be required in connection with this application or credit any overpayment to Deposit Account No. 02-4035. This authorization and request is not limited to payment of all fees associated with this communication, including any Extension of Time fee, not covered by check or specific authorization, but is also intended to include all fees for the presentation of extra claims under 37 CFR §1.16 and all patent processing fees under 37 CFR §1.17 throughout the prosecution of the case. This blanket authorization does not include patent issue fees under 37 CFR §1.18.

BROWDY AND NEIMARK, P.L.L.C.

Attorneys for Applicant(s)

By:

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Atty. Docket: WILLNER5

In re Application of:)	Conf. No.: 4415
)	
Itamar WILLNER et al)	Art Unit: 1641
)	
IA Appln. No: PCT/IL00/00048)	Examiner: NC Yang
U.S. Appln. No.: 09/889,936)	
)	
Date Filed: 1/25/2000)	Washington, D.C.
Nationalized: 11/19/2001)	
)	
For: DETECTION OF SMALL)	September 24, 2004
MOLECULES BY USE OF A)	
PIEZOELECTRIC SENSOR)	

REPLY TO RESTRICTION REQUIREMENT

Honorable Commissioner for Patents
U.S. Patent and Trademark Office
2011 South Clark Place
Customer Window, Mail Stop Amendment
Crystal Plaza Two, Lobby, Room 1B03
Arlington, VA 22202

Sir:

Applicants are in receipt of the Office Action of August 25, 2004, entirely in the nature of a restriction requirement.

Applicants have claimed priority of their priority application filed in Israel on January 5, 1999. Consistent with usual practice, the International Bureau of WIPO should have forwarded a copy of the Israeli application to the PTO.

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Response dated September 24, 2004
Reply to Office action of August 25, 2004

**Accordingly, applicants respectfully request the PTO to
acknowledge receipt of applicants' papers filed under §119.**

Restriction has been required among what the PTO deems to be eight (8) patentably distinct inventions. As applicants must make an election even though the requirement is traversed, applicants hereby respectfully and provisionally elect Group I, presently claims 79-82, directed to a protein, with traverse and without prejudice.

Respectfully, while the PTO has recognized that standard restriction practice is not applicable, and instead unity of invention practice under PCT Rules 13.1 and 13.2 apply, applicants believe that the unity of invention rules have not been applied correctly to the present case. Basically, the PTO takes the position that there is no common technical feature based on Rice, USP 4,314,821. However, while Rice teaches a piezoelectric oscillator for performing sandwich amino assays, Rice does not teach an apparatus for detecting small assayed molecules using neutralizing agents that comprise antibodies having the binding characteristics of the 5B3 monoclonal antibody, as claimed.

Thus, applicants respectfully maintain that all of applicants' claims relate to a single inventive concept, namely a protein molecule that has the binding characteristics

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of the 5B3 monoclonal antibody. Claim 79 claims a protein having an antigen-binding portion formed by two cooperating peptide sequences of Fig. 3A and Fig. 3B, which are the heavy and light chain variable regions of the 5B3 monoclonal antibody (see page 13, lines 13-16). All of the other groups relate to an apparatus, system or method using a protein molecule that has the binding characteristics of the 5B3 monoclonal antibody. Thus, applicants believe that 37 C.F.R. §1.475(b) applies, and unity of invention should be confirmed.

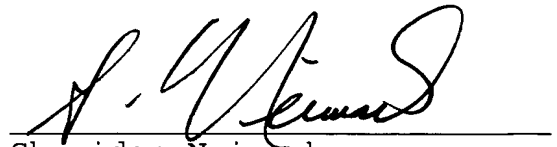
Accordingly, applicants respectfully request withdrawal of the requirement and examination of all the claims on the merits, fully consistent with 37 C.F.R. §1.475(b).

Applicants now respectfully await receipt of the results of a first examination on the merits.

Respectfully submitted,

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